



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,400	06/20/2001	Dennis Murphy	DIVER1120-4	4902

25225 7590 11/30/2005  
MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

EXAMINER

RAMIREZ, DELIA M

ART UNIT PAPER NUMBER

1652

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Response to Rule 312 Communication</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/886,400	MURPHY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Delia M. Ramirez	1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

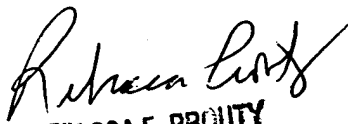
1. ☒ The amendment filed on 03 May 2005 under 37 CFR 1.312 has been considered, and has been:

- a) ☐ entered.
- b) ☐ entered as directed to matters of form not affecting the scope of the invention.
- c) ☐ disapproved because the amendment was filed after the payment of the issue fee.

Any amendment filed after the date the issue fee is paid must be accompanied by a petition under 37 CFR 1.313(c)(1) and the required fee to withdraw the application from issue.

- d) ☒ disapproved. See explanation below.
- e) ☐ entered in part. See explanation below.

*The request to correct the inventorship in this nonprovisional application under 37 CFR 1.48(a) is deficient because the new oath/declaration submitted is not by the actual inventor as required. Please note that the new oath/declaration includes inventors Jay M. Short and Eric J. Mathur, which are the inventors to be removed as stated in the request for correction of inventorship.*

  
**REBECCA E. PROUTY**  
**PRIMARY EXAMINER**  
 GROUP 1800  
 1600



Docket No.: 564462000320 / 004005 / D1120-4US  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Dennis MURPHY et al.

Application No.: 09/886,400

Confirmation No.: 4902

Filed: June 20, 2001

Art Unit: 1652

For: ALPHA-GALACTOSIDASES AND METHODS FOR MAKING AND USING THEM  
(AMENDED) Examiner: D. Ramirez

**STATEMENT OF DAN E. ROBERTSON PURSUANT TO 37 C.F.R. § 1.48(a)(2)**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

I, Dan E. ROBERTSON, declare as follows:

1. I am a joint inventor of the above-referenced patent application, U.S. Application Serial No. 09/886,400, filing date June 20, 2001, and am familiar with the contents thereof.
2. The error of failing to include myself, Dan E. ROBERTSON, as a joint inventor of the patent application occurred without any deceptive intention on my part.

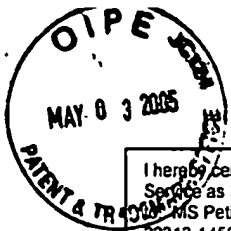
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

4-29-05

Date

Dan E. Robertson

Dan E. ROBERTSON



I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 441682755 US, in an envelope addressed to the MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: May 4, 2005

Signature: Norman Green  
(Norman Green)

Docket No.: 564462000320 /  
004005 / D1120-4US  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Dennis MURPHY et al.

Application No.: 09/886,400

Confirmation No.: 4902

Filed: June 20, 2001

Art Unit: 1652

For: ALPHA GALACTOSIDASES AND METHODS  
FOR MAKING AND USING THEM  
(AMENDED)

Examiner: Delia M. Ramirez, Ph.D.

**REQUEST FOR CORRECTION OF INVENTORSHIP**  
**PURSUANT TO 35 U.S.C. 116 & 37 C.F.R. § 1.48(a)**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The presently named applicants hereby petition the Commissioner to amend the above captioned application to add the name of Dan E. ROBERTSON as joint inventor. Enclosed are the following:

1. A statement from each person being added as inventor that the error in inventorship occurred without deceptive intent on his/her part. Dan E. ROBERTSON is the only added inventor.
2. A statement from each person being removed as inventor that the error in inventorship occurred without deceptive intent on his/her part. Jay M. SHORT and Eric J. MATHUR are being removed as inventors.
3. An oath or declaration by the actual inventor or inventors as required by § 1.63.

sd-258403  
05/09/2005 CCHAUI 00000058 031952 09886400

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4. The written consent of the assignee, Diversa Corporation.
5. The fee set forth in 37 C.F.R. § 1.17(i) of \$130.00.
  - ☐ is enclosed
  - ☒ is authorized to be charged to Deposit Account 03-1952. A Fee Transmittal (form PTO/SB/17i) is enclosed in duplicate for that purpose.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 564462000320.

It is believed that applicants have complied with requirements and correction of the inventorship in the present application is respectfully requested.

Dated: May 4, 2005

Respectfully submitted,

By 

Gregory P. Einhorn

Registration No.: 38,440  
MORRISON & FOERSTER LLP  
3811 Valley Centre Drive, Suite 500  
San Diego, California 92130  
(858) 720-5133



Docket No.: 564462000320 / 004005 / D1120-4US  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Dennis MURPHY et al.

Application No.: 09/886,400

Confirmation No.: 4902

Filed: June 20, 2001

Art Unit: 1652

For: ALPHA-GALACTOSIDASES AND METHODS FOR MAKING AND USING THEM  
(AMENDED) Examiner: D. Ramirez

**STATEMENT OF ERIC J. MATHUR PURSUANT TO 37 C.F.R. § 1.48(a)(2)**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

I, Eric J. MATHUR, declare as follows:

1. I am not a joint inventor of the above-referenced patent application, U.S. Application Serial No. 09/886,400, filing date June 20, 2001, and was named as a joint inventor in error.
2. The error of including myself, Eric J. MATHUR, as a joint inventor of the patent application occurred without any deceptive intention on my part.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

4/29/05  
Date

  
ERIC J. MATHUR



Docket No.: 564462000320 / 004005 / D1120-4US  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Dennis MURPHY et al.

Application No.: 09/886,400

Confirmation No.: 4902

Filed: June 20, 2001

Art Unit: 1652

For: ALPHA-GALACTOSIDASES AND METHODS FOR MAKING AND USING THEM  
(AMENDED) Examiner: D. Ramirez

**STATEMENT OF JAY M. SHORT PURSUANT TO 37 C.F.R. § 1.48(a)(2)**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

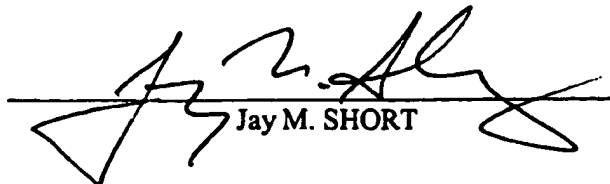
Dear Sir:

I, Jay M. SHORT, declare as follows:

1. I am not a joint inventor of the above-referenced patent application, U.S. Application Serial No. 09/886,400, filing date June 20, 2001, and was named as a joint inventor in error.
2. The error of including myself, Jay M. SHORT, as a joint inventor of the patent application occurred without any deceptive intention on my part.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

4/29/05  
Date

  
Jay M. SHORT



Attorney Docket No.: 564462000320 / 004005 / D1120-4US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**DECLARATION FOR PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**ALPHA-GALACTOSIDASES AND METHODS FOR MAKING AND USING THEM  
(AMENDED)**

the specification of which was filed on June 20, 2001 as Application No. 09/886,400.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by an amendment, if any, specifically referred to herein.

I acknowledge the duty to disclose all information known to me that is material to patentability in accordance with Title 37, Code of Federal Regulations, § 1.56.

**FOREIGN PRIORITY CLAIM**

I hereby claim foreign priority benefits under Title 35, United States Code § 119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

☒ no foreign applications have been filed

☐ foreign application have been filed as follows:

**EARLIEST FOREIGN APPLICATION(S), IF ANY FILED WITHIN 12 MONTHS  
(6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION**

Application Number	Country	Date of Filing	Priority Claimed Under 35 USC 119
			___ Yes No ___
			___ Yes No ___
			___ Yes No ___

**ALL FOREIGN APPLICATION(S), IF ANY FILED MORE THAN 12 MONTHS  
(6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION**

Application Number	Country	Date of Filing

**CLAIM FOR BENEFIT OF EARLIER U.S. PROVISIONAL APPLICATIONS**

I hereby claim priority benefits under Title 35, United States Code §119(e), of any United States provisional patent application(s) listed below:

☒ no U.S. provisional applications have been filed.

☐ U.S. provisional application have been filed as follows:

Application Number	Date of Filing	Priority Claimed Under 35 USC 119
		___ Yes No ___
		___ Yes No ___
		___ Yes No ___

**CLAIM FOR BENEFIT OF EARLIER U.S./PCT APPLICATION(S)**

I hereby claim the benefit under Title 35, United States Code, §120 of the United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose all information that is material to patentability in accordance with Title 37, Code of Federal Regulations, §1.56 which became available to me between the filing date of the prior application and the national or PCT international filing date of this application:

☐ no U.S./PCT applications have been filed.

☒ U.S./PCT application have been filed as follows:

Application Number	Date of Filing	Status (Patented/Pending/Abandoned)
09/619,032	07/19/2000	Pending
09/407,806	09/28/1999	Pending
08/613,220	03/08/1996	Patented

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint:

All practitioners at Customer Number 45975

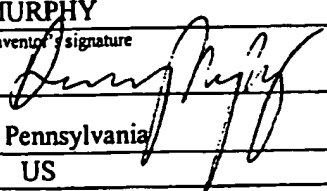
all of **Morrison & Foerster LLP**, 3811 Valley Centre Drive, Suite 500, San Diego, California 92130-2332, jointly, and each of them severally, my attorneys at law/patent agent(s), with full power of substitution, delegation and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the U. S. Patent and Trademark Office connected therewith.

Please mail all correspondence to Gregory P. Einhorn, whose address is:

**Morrison & Foerster LLP**  
3811 Valley Centre Drive  
Suite 500  
San Diego, California 92130-2332

Please direct telephone calls to: Gregory P. Einhorn at (858) 720-5133.

Please direct facsimiles to: (858) 720-5125

Full name of sole or first inventor <b>Dennis MURPHY</b>	
Sole or first inventor's signature 	Date <b>May 10 2006</b>
Residence <b>Malvern, Pennsylvania</b>	
Citizenship <b>US</b>	
Mailing Address  <b>1320 Eaves Spring Road Malvern, Pennsylvania 19355</b>	

Full name of second inventor, if any <b>John REID</b>	
Second inventor's signature	Date
Residence <b>Ardmore, Pennsylvania</b>	
Citizenship <b>US</b>	
Mailing Address  <b>44 St. Paul's Road Ardmore, Pennsylvania 19003</b>	

Full name of third inventor, if any <b>Dan E. ROBERTSON</b>	
Third inventor's signature	Date
Residence <b>San Diego, California</b>	
Citizenship <b>US</b>	
Mailing Address  <b>6332 Oleander Way San Diego, California 92130</b>	

Full name of fourth inventor, if any	
Fourth inventor's signature	Date
Residence	
Citizenship	
Mailing Address	



Attorney Docket No.: 564462000320 / 004005 / D1120-4US

Full name of sole or first inventor <b>Dennis MURPHY</b>	
Sole or first inventor's signature	Date
Residence <b>Malvern, Pennsylvania</b>	
Citizenship <b>US</b>	
Mailing Address  <b>1320 Eaves Spring Road Malvern, Pennsylvania 19355</b>	

Full name of second inventor, if any <b>John REID</b>	
Second inventor's signature <i>John Reid</i>	Date <b>13 Apr 2005</b>
Residence <b>Ardmore, Pennsylvania</b>	
Citizenship <b>US</b>	
Mailing Address  <b>44 St. Paul's Road Ardmore, Pennsylvania 19003</b>	

Full name of third inventor, if any <b>Dan E. ROBERTSON</b>	
Third inventor's signature <i>Dan E. Robertson</i>	Date <b>8-29-05</b>
Residence <b>San Diego, California</b>	
Citizenship <b>US</b>	
Mailing Address  <b>6332 Oleander Way San Diego, California 92130</b>	

Full name of fourth inventor, if any	
Fourth inventor's signature	Date
Residence	
Citizenship	
Mailing Address	



Docket No.: 564462000320 / 004005 / D1120-4US  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Dennis MURPHY et al.

Application No.: 09/886,400

Confirmation No.: 4902

Filed: June 20, 2001

Art Unit: 1652

For: ALPHA-GALACTOSIDASES AND METHODS FOR MAKING AND USING THEM  
(AMENDED) Examiner: D. Ramirez

**CONSENT OF ASSIGNEE UNDER 37 C.F.R. § 3.73(b) AND 37 C.F.R. § 1.48(a)(5)**  
**TO CORRECT INVENTORSHIP**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Diversa Corporation is the assignee of the entire right, title and interest in the invention claimed in the above captioned U.S. patent application 09/886,400 by virtue of an assignment recorded by the U.S. Patent and Trademark Office on March 13, 2002, with Reel 012734 and Frame 0741. The undersigned, who is authorized to execute this Consent on behalf of Diversa Corporation, states that Diversa Corporation consents to the correction of inventorship to add Dan E. ROBERTSON as co-inventor and to remove Jay M. SHORT and Eric J. MATHUR as co-inventors.

Executed on April 29, 2005, at San Diego, California

Signature: Carolyn Erickson

Printed Name: Carolyn Erickson

Title: Vice President, Intellectual Property



05-06-05

FILED  
16828

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)		Application Number	09/886,400
		Filing Date	June 20, 2001
		First Named Inventor	Dennis MURPHY
		Art Unit	1652
		Examiner Name	D. Ramirez
Total Number of Pages in This Submission	14	Attorney Docket Number	564462000320

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form (1 page + duplicate)  <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Reply to Missing Parts/Incomplete Application  <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____  <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Request for Correction of Inventorship (2 pages) Executed Statements of added and removed Inventors (3 pages) Executed Oath/Declaration of Actual Inventors (5 pages) Executed Consent of Assignee (1 page) Return Receipt Postcard
<div>Remarks</div> <div>Customer No. 45975</div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	Gregory P. Einhorn		
Date	May 4, 2005	Reg. No.	38,440

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 441682755 US, in an envelope addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.	
Dated: May 4, 2005	Signature:  (Norman Green)



PTO/SB/17i (11-04)

Approved for use through 7/31/2007. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

**PROCESSING FEE  
Under 37 CFR 1.17(i)  
TRANSMITTAL**

(Fees are subject to annual revision)

Send completed form to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Application Number	09/886,400
Filing Date	June 20, 2001
First Named Inventor	Dennis MURPHY
Art Unit	1652
Examiner Name	D. Ramirez
Attorney Docket Number	564462000320

Enclosed is a paper filed under 37 CFR 1.48 that requires a processing fee (37 CFR 1.17(i)).  
Payment of \$ 130.00 is enclosed.

This form should be included with the above-mentioned paper and faxed or mailed to the Office using the appropriate Mail Stop, if applicable. For transmittal of petition fees under 37 CFR 1.17(f), (g) or (h), see form PTO/SB/17p.

**Payment of Fees** (small entity amounts are NOT available for the petition fees)

- ☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 03-1952 :  
☒ Processing fee under 37 CFR 1.17(i) ☒ Any deficiency of fees and credit of any overpayments

Enclose a duplicative copy of this form for fee processing.

- ☐ Check in the amount of \$ \_\_\_\_\_ is enclosed.  
☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

**Processing Fees under 37 CFR 1.17(i): Fee \$130**Fee Code 1808 for all,  
Except for §1.221 papers (Fee Code 1803)

For papers filed under:

- § 1.28(c)(3) - for processing a non-itemized fee deficiency based on an error in small entity status.  
§ 1.41 - for supplying the name or names of the inventor or inventors after the filing date without an oath or declaration as prescribed by §1.63, except in provisional applications.  
§ 1.48 - for correcting inventorship, except in provisional applications.  
§ 1.52(d) - for processing a nonprovisional application filed with a specification in a language other than English.  
§ 1.53(b)(3) - to convert a provisional application filed under § 1.53(c) into a nonprovisional application under §1.53(b).  
§ 1.55 - for entry of late priority papers.  
§ 1.99(e) - for processing a belated submission under § 1.99.  
§ 1.103(b) - for requesting limited suspension of action, continued prosecution application (§ 1.53(d)).  
§ 1.103(c) - for requesting limited suspension of action, request for continued examination (§ 1.114).  
§ 1.103(d) - for requesting deferred examination of an application.  
§ 1.217 - for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.  
§ 1.221 - for requesting voluntary publication or republication of an application. Fee Code 1803  
§ 1.281(c)(5) - for processing a second or subsequent protest by the same real party in interest.  
§ 1.497(d) - for filing an oath or declaration pursuant to 35 U.S.C. 371(c)(4) naming an inventive entity different from the inventive entity set forth in the international stage.  
§ 3.81 - for a patent to issue to assignee, assignment submitted after payment of the issue fee.

Signature

May 4, 2005

Date

Gregory P. Einhorn

Typed or printed name

38,440

Registration No., if applicable